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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,662	04/27/2001	Eva Raschke	8325-0012	9004
20855 7590 08/28/2008 ROBINS & PASTERNAK 1731 EMBARCADERO ROAD SUITE 230 PALO ALTO, CA 94303				
EXAMINER KELLY, ROBERT M				
ART UNIT		PAPER NUMBER		
1633				
MAIL DATE		DELIVERY MODE		
08/28/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 09/844,662	Applicant(s) RASCHKE ET AL.
Examiner ROBERT M. KELLY	Art Unit 1633

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 August 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Robert M Kelly/
Examiner of Art Unit 1633

Continuation of 5. Applicant's reply has overcome the following rejection(s): Applicant's reply overcomes the double-patenting rejections, due to filing of TDs to each of the patents, except for the 6,919,204 and 6,824,978 patents. With regard to the filing of the declaration of Dr. Case on 7/9/08, the rejections of the claims under 102(e) by Patent Nos. 7,220,719; 7,163,824; 7,013,219; 6,979,539; 6,933,113; 8,824,978; 6,689,558; 6,607, 882; and 6,453,242 (to be clear, those patents which are declared by Dr. Case), are withdrawn as required by 35 USC 103(c).

Continuation of 11. does NOT place the application in condition for allowance because: With regard to the arguments against Applicant's non-withdrawn rejections under 102(e) and non-withdrawn rejections for double patenting, Applicant argues that the references do not necessarily and inevitably bind accessible regions of cellular chromatin, citing a references that histones bind to a region which the specific zinc finger utilized also binds, to thereby argue that the zinc fingers in the art may or may not bind to accessible regions, and the Examiner cannot argue that the region is actually "accessible", and therefore it is not proper anticipation. Such is again not persuasive. The specification teaches that the accessible region is defined as "a site in a chromosome, episome or other cellular structure comprising a nucleic acid, in which a target site is present in the nucleic acid can be bound by an exogenous molecule which recognizes the target site" (p. 11, paragraph 2). No distinction is made as to the type of exogenous molecule, hence, because the molecule itself binds, the molecule is one such exogenous molecule, as it is non-naturally occurring and it is therefore binding in an accessible region. Further, the cited references teach that the zinc fingers can bind to regions that are bound in chromatin structure, but that necessarily means it can also bind to Applicant's argued accessible region, as the absence of other proteins does even less to preclude the binding of the Zinc finger. To wit, the cited art does not say that Zinc fingers only bind to cellular chromatin, or inaccessible sites, but that in some cases it will bind to the cellular DNA whether or not it is bound up in cellular chromatin. Further, if the Examiner were to accept Applicant's arguments, Applicant's arguments actually demonstrate that their claims are not enabled, as the structure of the DNA segments which bind to the zinc finger proteins which will be accessible are not distinguished in any fashion from those which are not, and hence, the Artisan would have to find and test every possible probe of chromatin structure to see if any of them differentially bind to the region, then determine if the Zinc binds to the region, and such would necessarily be undue experimentation as it amounts to inventing the breadth of Applicant's invention for Applicant. However, the more reasonable interpretation is provided by Applicant's specification, p. 11, paragraph 2, which states that if it binds, it binds to an accessible region, and hence, the Argument against enablement is not believed proper. Further, as Applicant's own argued description states that the accessible region is "generally one that does not have a typical nucleosome structure" (p. 13, lines 11-12), which is broad, and does not make any requirements as to any structure in its broadest reasonable interpretation, and hence, is non-limiting as a definition, because it is "generally" one of these regions, but not always. Still further, if the Examiner were to ignore the reality of the definition and remove the word "generally" from the definition, it would be in direct conflict with the other definition, on page 11, paragraph (discussed above). On the other hand, as the definitions are coextensive, as the term "generally" removes the import of the definition, it appears the examiner's definition is proper and the region, because it binds to the zinc finger, is actually an accessible region. Lastly, it is repeated from the previous after-final rejection, that, in addition to the enablement rejection above, it would appear that if the Examiner were to accept the arguments of Applicant, that they did not actually possess the invention claimed. To wit, p. 11, paragraph 2 also states that it is believed that the binding site is not packaged into normal chromatin, and that, even in light of their belief, they do not wish to be bound by any particular theory with regard to the binding site. As such, this is tantamount to an admission that these sites are not known as to whether or not they bind a site in accessible chromatin. Hence, the Artisan would not have been able to determine, according to Applicant's proposed definition, that Applicant possessed the invention as claimed, or whether it was a wish list of options on the part of Applicant. However, again, the broader reasonable interpretation is made by the Examiner, in which, if the Zinc finger binds the DNA it must be an accessible region. The rejections as anticipated by Shin, et al., and/or by Stacey, et al., have not been argued by Applicant, however, it is argued for the pending appeal that these are properly anticipated. First, if the Examiner's interpretation of what an accessible region is proper, then it is necessarily anticipation in each case. Second, if Applicant's interpretation of their specification is accepted, there is simply no way to determine whether or not the zinc fingers of Zhang and/or Stacey are binding to an accessible site, as the office does not have the facilities to determine such. Because of that, it is up to Applicant to demonstrate that the site is not accessible under their interpretation of the specification. Hence, these rejections remain, and the withdrawn claims are not rejoined. Moreover, it is stressed that such rejoinder would require further consideration, and hence, Applicant would be required to file an RCE prior to consideration of such at this point anyway. The Examiner hopes that the responses have been sufficient to help Applicant clarify the issues for appeal, and looks forward to the filing of an appeal brief. Applicant is advised to carefully file their appeal brief to comply with 37 CFR 41.37(c)(1)(i)-(x). The board of appeals now has a staff to review the submission for compliance, and missing references and documents and a failure to fully comply with any of these provisions, will yield a non-compliant appeal brief notice. As a general form of guidance, the submission should be a set of stand-alone documents, not requiring the Judges to go back to the application file to determine or confirm anything.